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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/758,641 | 01/15/2004 | David J. Bender | LEEE 2 00356 | 5821 |
| 7590 11/26/2004 | | | EXAMINER | |
| Fay, Sharpe, Fagan, Minnich & McKee, LLP 7th Floor 1100 Superior Avenue Cleveland, OH 44114-2579 | | | KERNS, KEVIN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1725 | |

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/758,641 | Applicant(s) BENDER ET AL. | |
| | Examiner Kevin P. Kerns | Art Unit 1725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "244" (should be labelled in Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 26 is objected to because of the following informalities: in the 1st line, "engine welding" should be changed to "integrated welder, generator and compressor unit" (or an equivalent) for further clarity. In the 2nd line, "is" should be deleted after "that". Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 6, 8, 26, 32, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 83-85 and 90-92 of copending Application No. 10/390,436 (also refer to Publication No. US 2004/0182846 for claims as originally presented in 10/390,436). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed integrated welder, generator, and compressor unit and its method of use include the following: (providing) a housing that at least partially contains components of the welder, generator, compressor, and engine; (providing) an electric current generator in the housing and connected to the engine; (providing) an electric air compressor within the housing; connecting the air compressor to a drive of the engine to provide a powering current; and (providing) an air accumulator (receiver) tank and a pressure monitor. One of ordinary skill in the art would have recognized that the beltless and clutchless connectors of copending Application No. 10/390,436 are a subset of a group of power-providing electrical connection components used in the

present application, as use of these connectors are advantageous for less frequent maintenance compared to similar components that include belts and a clutch. It would have been obvious to one of ordinary skill in the art to exclude the "(providing the) beltless and clutchless" limitation set forth in claims 83 and 90 of copending Application No. 10/390,436, as open-ended "comprising" language exists in the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-23 and 26-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Gustafson (US 1,929,887).

Gustafson discloses an integrated welder, generator, and compressor unit, and a method of using it, such that the unit includes a housing that contains components of a welder, generator 2, air compressor, and internal combustion engine 3; an electric

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generator with a connection to welding electrode 4; and a beltless and clutchless connector that connects the air compressor (having associated air receiver tank 46 and pressure monitor and valves) to an auxiliary drive of the internal combustion engine 3, such that the engine 3 drives the generator 2 and air compressor (page 1, lines 1-9 and 62-89; page 2, lines 1-23 and 68-80; page 3, lines 101-106; page 4, lines 63-71; and Figures 1 and 2).

7. Claims 1-23 and 26-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Colella (US 6,051,809).

Colella discloses a self-contained integrated welder/generator and compressor apparatus, in which the apparatus 10 includes a housing 14 that contains components of the welder, generator, and compressor; an internal combustion engine 20 mounted in the housing 14; an electric current generator 28 (driven by engine 20) and air compressor 34 mounted inside the housing 14; a connector (belt pulley drive system) connected to an auxiliary drive of the engine 20; electrical and air outlets 66; and an air accumulator (receiver) tank 38 with pressure monitor and valves (abstract; column 2, lines 5-39 and 56-67; column 3, lines 1-67; column 4, lines 1-31; and Figures 1-6).

8. Claims 1-23 and 26-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Brofft et al. (US 6,670,580).

Brofft et al. disclose a power box that includes an integrated generator, compressor, and welding power supply unit, and a method of using it, such that the unit

10 includes a housing 10c that contains components of a welding power supply 44, generator (alternator unit 42), air compressors (48,50), and internal combustion engine 40; the generator being connected with a connection to engine 40; and a beltless and clutchless connector that connects the air compressors (having associated air accumulator (receiver) tanks 46a,46b and pressure monitor/control panel and valves) to an auxiliary drive of the engine 40 (abstract; column 3, lines 42-67; column 4, lines 1-67; column 5, lines 1-10 and 41-67; column 6, lines 1-63; column 7, lines 54-67; column 8, lines 20-67; column 9, lines 1-37; and Figures 1-5).

9. Claims 1-23 and 26-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Bankstahl et al. (US 6,674,046).

Bankstahl et al. disclose a portable and fully integrated welder and compressor combination that includes a housing 12 that contains components of the welder combination 10, generator, and compressor; an internal combustion engine 58 mounted in the housing 12; an electric current generator 67 (driven by engine 58) and air compressor 68 mounted inside the housing 12; a connector (belt pulley drive system) connected to an auxiliary drive of the engine 58; electrical and air outlets (36,54); an air accumulator (receiver) tank; and a pressure monitor/control system (26,28) and valves (abstract; column 1, lines 44-67; column 2, lines 1-40; column 3, line 2 through column 6, line 62; and Figures 1-4 and 7).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 24, 25, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gustafson (US 1,929,887), Colella (US 6,051,809), Brofft et al. (US 6,670,580), or Bankstahl et al. (US 6,674,046) in view of Di Novo et al. (US 6,596,972).

Gustafson, Colella, Brofft et al., and Bankstahl et al. individually disclose the elements of independent claims 1 and 26 (including pertinent dependent claims) above. Neither Gustafson, Colella, Brofft et al., nor Bankstahl et al. discloses that the housing has wheels for rolling over a ground surface.

However, Di Novo et al. disclose a welding accessory arrangement for a welder, in which the welder includes a housing 10 that has casters/wheels (250,252) on its base, for the purpose of convenient relocation of the welder to various locations (abstract; column 6, lines 49-51; column 8, lines 4-12; and Figures 1 and 4).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify any of the welder/generator/compressor systems of Gustafson, Colella, Brofft et al., or Bankstahl et al., by placing casters/wheels on the base of the housing, as disclosed by Di Novo et al., in order to conveniently relocate the welder to various locations (Di Novo et al.; column 6, lines 49-51; column 8, lines 9-12).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 11/20/04*
Examiner
Art Unit 1725

KPK
kpk
November 20, 2004